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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,112	09/10/2003	Kenneth L. Luskey	016325-003721US	6844

20350 7590 07/06/2005

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EXAMINER

COOK, REBECCA

ART UNIT PAPER NUMBER

1614

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/660,112	LUSKEY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Rebecca Cook	1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 and 50-52 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 9/10/03 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/30/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Title and Abstract**

The title of the invention is not descriptive to the invention as now claimed. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is objected to because it does not describe the invention as now claimed. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

Claims 1-8 and 50-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claims recite a method of treating obesity. However, there is no disclosure in the specification of what aspect(s) of obesity are being treated, e.g. whether the instant method treats obesity by causing weight loss or treats the side effects of obesity such as insulin resistance, type II diabetes and hyperlipidemia.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 50-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,624,194, directed to a method of treating type 2 diabetes; claims 1-17 of U.S. Patent No. 6,646,004, directed to a method of modulating insulin resistance; claims 1-6 of U.S. Patent No. 6,613,802, directed to a method of treating hyperuricemia; and claims 1-11 or U.S. Serial No. 6.262,118, directed to a method of treating type 2 diabetes. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the cited patents discloses a method of treating a condition associated with obesity [see applicants disclosure on page 15, lines 9-14] and would thus render the instant method of treating obesity obvious.

Claims 1-8 and 50-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-22 and 24-30 of copending Application No. 10/432,742, directed to a method of modulating insulin resistance and claims 1-9, 13-14 and 56-61 of copending Application No. 10/382,186, directed to a method of treating syndrome X. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the cited applications discloses a method of treating a condition associated with

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obesity [see applicants disclosure on page 15, lines 9-14] and would thus render the instant method of treating obesity obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Information Disclosure Statement***

The following U.S. SN appears to be incorrect because the inventor is not Wille and the subject matter is to an electrical apparatus: 5,726,987.

Neuman and Scholosstein were not considered because no publication dates were available.

The following references were not considered because they were not available in the file : Bardin, Fanelli, Gavin III, McMahon, Univ. Michigan Medical Center J, Turner and Clapham, Vedell and Passananti and Wright.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cook whose telephone number is (571) 272-0571. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (571) 272-0951.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Renee Jones (571) 272-0547 in Customer Service.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The official fax number is 571-273-8300.

Rebecca Cook



Primary Examiner  
Art Unit 1614

June 22, 2005